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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY: DOCKET NO.
08/945,249	02/02/98	VERE HODGE	R P31158

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EXAMINER
TRAVERS, R

ART UNIT	PAPER NUMBER
1614	18

DATE MAILED: 04/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/945,249

Applicant(s)
Vere Hodge et al

Examiner
RUSSELL TRAVERS

Group Art Unit
1614



☒ Responsive to communication(s) filed on Jan 21, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 3-14, and 16-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 3-14, and 16-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

The request for continuing prosecution filed January 21, 2000 has been received and entered into the file.

Claims 1, 3-14 and 16-20 are presented for examination.

Applicant's election with traverse of Group I, claims 1 and 4 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that restriction was not required in the international examination process. This is not found persuasive because failure to require additional fees to examine all included inventions fails to preclude the instant restriction..

The requirement is still deemed proper and is therefore made FINAL.

This application contains claims 5-14 drawn to an invention non-elected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1, 4 and 16-20 will be examined to the extent they read on the elected subject matter.

Claims 3 and 5-14 reading on non-elected subject matter are withdrawn from consideration.

Applicant's arguments filed January 21, 2000 have been fully considered but they are not deemed to be persuasive.

Art Unit:

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1, 4 and 16-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Kenig et al or Boyd et al, all of record..

Kenig et al or Boyd et al, all of record. teach the claimed compounds as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. These medicament are taught as useful for treating those viral diseases herein claimed. Claims 1, 4 and 16-20, and the primary references, as to:

1) various isomers employed as the preferred therapeutic agents.

The skilled artisan, possessing a compound for a particular therapeutic use possesses all isomers, analogs, homologs, bioisosteres, acids, esters and salts of such compounds for that same use. In the instant case, the claims read on employing compounds residing in the prior art, for the same use. Absent information illustrating

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some unexpected benefit residing in those prior art compounds, unidentified in the prior art; the instant claims, reading on obvious subject matter remain properly rejected as obvious.

RESPONSE TO ARGUMENTS

Applicants aver a showing of unexpected benefits residing in the specification at page 4; Examiner was unable to locate a showing of unexpected benefits. As stated below; evidence as to unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). The data provided by Applicants is neither clear, nor convincing or reasonably commensurate in scope with the instant claims. Absent claims commensurate with the showing of unexpected benefits, or a showing reasonably commensurate with the instant claims, such claims remain properly rejected under 35 USC 103. Evidence supporting un-obviousness by virtue of possessing unexpected benefits must be submitted in declaration form. All information in the specification is attested, as should any information subsequently filed. If Applicants attest to published data, that such data was done at their direction and guidance; these averments will support averments of un-obviousness.

Examiner cited prior art teaches those phosphate esters herein envisioned. The Examiner cited prior art taught the instant compounds as possessing chiral atom, thus,

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producing optical isomers. Possessing a compound for a medicinal use, this skilled artisan possesses all isomers for this compound. Absent a illustration of unexpected benefits residing in one, or another, isomer these uses are obvious to the skilled artisan.

The references herein relied upon establish a strong prima facie case of obviousness as to applicants' invention. The claimed subject matter is of such a nature that the differences between said subject matter and the teachings of the prior art of record would have rendered applicants' subject matter as a whole obvious to those skilled in the art at the time of applicants' invention. The references clearly establish that the claim designated components were old, of known character and that one skilled in the art would have been motivated to employ said components in the manner herein claimed to obtain the claimed, expected results. The claims are therefore properly rejected under 35 USC 103.

Applicant avers the presence of unexpected benefits in the claimed subject matter, yet fails to illustrate such. Evidence as to unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). The data provided by Applicants is neither clear, nor convincing or reasonably commensurate in scope with the instant claims. Absent claims commensurate with the showing of unexpected benefits, or a showing

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reasonably commensurate with the instant claims, such claims remain properly rejected under 35 USC 103.

NO claims are allowed.

Any inquiry concerning this communication should be directed to Russell Travers at telephone number (703) 308-4603.

A handwritten signature in black ink, appearing to read 'Russell Travers', with a long horizontal line extending to the right.

**Russell Travers
Primary Examiner
Art Unit 1614**